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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
512100-2034

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
10/823,119	April 12, 2004

First Named Inventor
MÜLLER et al.

Art Unit	Examiner
1615	GHALI, Isis

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____.

☑ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 48,104

/Howard C. Lee/
Signature

Howard C. Lee
Typed or printed name

202-292-1539
Telephone number

8 May 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. Obviousness-type Double Patenting (ODP) Over Claims of 10/835,997 ('997 application) and U.S. Patent 6,348,501 ('501 patent) Was Made in Error for Using Multiple References

Claims 1-16, 18 and 19 in the present application are directed toward a topical patch which is specific for capsaicin/capsaicin analog or mixture thereof (hereafter collectively referred to as "capsaicin"); **claim 17** is directed toward a method of treating neuropathic pain with the patch of claim 1 and **claim 20** is directed toward the method of producing the patch of claim 1.

Claims 32-42 of the '997 application is directed toward the preparation of transdermal therapeutic system (TTS) with contains "at least one active substance".

The Examiner and the applicants apparently agree that the claims of the '997 application do not teach capsaicin. However, the applicants continue to assert that the Examiner's rationale for including the '501 patent is in error as an ODP is restricted to a comparison of the claims in question.

While a secondary reference may be used for dictionary or clarification purposes, this is not the use of the '501 patent by the Examiner here. When restricted to a comparison of the claims, there is no teaching or direction from the '997 application claims that the "at least one active substance" is capsaicin.[1]

At best, the '501 patent shows that capsaicin was used in a topic lotion. However, this does not show that for dictionary or clarification purposes, one of ordinary skill in the art would have been directed to select capsaicin when presented only with the claims of the '997 application and given the scope of compounds which could be considered to be encompassed by the phrase "at least one active substance". The impermissible use of the '501 patent was to supply a missing element from the '997 application, i.e. the direction necessary to select capsaicin as the "at least one active substance".

[1] "…The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994)("The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.")…" MPEP 2144.08, section II.

Applicants also note that '501 can also be attacked on the ground that the teaching for capsaicin is for the lotion described in the '501 patent which is completely unrelated to the TTS of the '997 claims or the topical patch of the present claims.

Applicants further note that while the discussion has been focused on capsaicin, the TTS and topical patch also differ in that the claimed topical patches also specify that the polysiloxane matrix are a mixture of medium tack and high tack polysiloxane and that the concentration of the capsaicin has a concentration of between 20% to 90% by weight of saturation concentration in the microreservoir droplets.

Lastly, the applicants note that the Examiner rejected all of the applicants' ***topical patch*** claims with the ***process of making claims*** of the '501 patent. While this is not necessarily precluded, in the present situation, the description of the TTS in the '501 patent is non-obvious for the reasons cited above and the TTS become even further removed from the applicants' claimed topical patch when the applicants' dependent claims are considered, i.e. claims 2-16, 18 and 19. Likewise, the applicants' generic process of making claim 20 differs from the process of making claim of the '501 patent because of the differences between the topical patch and TTS and is even further removed from the '501 patent dependent claims which define even more specific process conditions which are not recited in claim 20.

Therefore, the ODP rejection of claims 1-20 was in error as the '997 application did not teach or suggest the applicants' claimed invention and the '501 patent was clearly utilized to address a deficiency from the claims of the '997 application claims as applied to an ODP rejection.

II. Obviousness rejections made over U.S. Patent 5,788,983 ('983 patent) in view of U.S. Patents 6,348,501 ('501 patent) and 6,818,671 ('671 patent) and U.S. Patent Appl. Publ. 2005-0079206 ('206 application) were in error because applicants' claims and cited references were not considered as a whole

The applicants' previous response appears to have been misinterpreted by the Examiner with regard to the number of references which can be used to formulate an obviousness rejection.

While there is no limit on the number of references, each additional reference relied upon by the Examiner provides *prima facie* evidence that the applicants' claimed invention was unobvious rather than being obvious because "[a] prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied,* 469 U.S. 851; *see also MPEP 2141.02, section VI.*

The consequence of having to rely on multiple references is that the collective "whole" becomes larger with each additional reference thereby making it less likely that one of ordinary skill in the art would be able to arrive at the requisite combination of elements taught by the applicants' claim; the Examiner cannot approach the reference by simply homing in on the element needed to support the rejection while ignoring the rest of the reference, i.e. if a reference is cited, the Examiner is stuck with all of its teachings, not just the element desired for use in the rejection.

As noted in the previous response, when considering the references as a whole, the '983 patent, while generally directed toward the delivery of an active agent, contained at least five (5) differences which include:

(1) being directed toward delivery of an estrogenic steroid with no direction given to capsaicin (and therefore no direction to the between 20% and 90% by weight of saturation concentration of capsaicin in the applicants' claims);

(2) not explicitly teaching capsaicin as an active agent being dissolved in microreservoirs;

(3) the polysiloxane matrix is not taught to be a mixture of a polysiloxane of medium tack and a polysiloxane of high tack;

(4) failing to teach that the polysiloxane matrix is a self-adhesive amine-resistant polysiloxane matrix;

(5) the '983 patent requires a requires a "means which desirably provide variable transdermal absorption rates", i.e. a permeability-regulating polymer membrane (see Figure 1 and 2 of Chien and col. 3, lines 45-54) which applicants' invention does not.

The '501 patent teaches the capsaicin, but in the context of a ***lotion*** (a suspension or dispersion) where the capsaicin is ***encapsulated*** by an encapsulation agent not in the context of microreservoirs. This is neither the mechanism of delivery of the active agent for either the applicants' invention or for the '983 patent. Moreover, the '501 patent refers to "three critical ingredients, capsaicin, anathestic (sic) and an analgesic" (see col. 1, lines 14-16) and refers to a specific carrier system which is completely different that that of the '501 patent to alleviate the burning associated with the administration of capsicum (see col. 2, lines 57-62 – range of capsaicin being in the range of 0.00125% to 1% with higher levels such as 62% being associated

with a burning sensation). There is nothing from the '501 reference which would suggest the appropriateness of using capsaicin in the transdermal dosage units of the '983 patent.

That the '501 patent had difficulty in achieving the applicants' claimed concentration of between 20% and 90% by weight of saturation is not surprising given the applicants' disclosure in the background of the invention, i.e. page 1, lines 13-30 refer to U.S. Patents 6,248,788 and 6,239,180 which were only able to achieve capsaicin concentrations of between 5% to 10% by weight and still be acceptable for use in the treatment of neuropathic pain.

The description of the '671 patent by the Examiner is very misleading and clearly shows that this reference was not considered as a whole in that while capsaicin is mentioned in the specification, it is mentioned as an optional ingredient ("Other ingredients may also optionally be included in the composition, for example, capsicum oleoresin, capsaicin…" – see col. 3, lines 57-58). However, one of ordinary skill in the art would clearly see that the '671 patent is not directed toward capsaicin as the primary active ingredient, but towards the delivery of ***nimesulide*** (see Abstract and Summary of the Invention). Moreover, the analysis of the '671 patent appears to be restricted to the recognition of "buzzwords" such as DGME with no appreciation as to how they are being used in the invention, i.e. the '671 patent has no relationship to the microreservoirs of the either the '983 patent or the applicants' claimed invention.

When considering the '206 publication reference as a whole, it is clearly directed toward a means for improving transdermal delivery of ***rotigotine***, a dopamine agonist compound used in the treatment of Parkinson's disease (see Abstract and Summary of the Invention). The use and development of microreservoirs in the '206 publication is for the purpose of enhancing the flux of rotigotine which has no relationship to the delivery of NSAIDS or vasodilators as in the '983 patent or to the delivery of capsaicin in the applicants' claimed invention.

Therefore, when considering the references cited as a whole, one of ordinary skill in the art is confronted with a transdermal polymer dosage unit for the delivery of NSAIDS and vasodilators, a lotion comprising capsaicin, a composition containing nimesulide as an active ingredient with capsaicin as at best an optional ingredient and a transdermal delivery device for the delivery of rotigotine and would not have arrived at the applicants claimed invention when considering this hodge-podge of teachings and the state of the art with regard to achieving higher concentrations of capsaicin for topical use, i.e. when having to consider the references as a whole

including the teachings which were not relied upon in the rejection, there is virtually an infinite number of possible solutions to the problem (given the number of references cited, it is unclear even what the solution to the problem would have been beside trying to approximate the applicants' claims).

Moreover, there was nothing within the respective teaching which would have suggested to one of ordinary skill in the art that selecting an element out of context from one invention would have had the requisite effect on a completely different active ingredient or means of topical administration; to the contrary, each of the specific reference was uniquely tailored to the active ingredient recited in their respective specifications, i.e. there was no predictability of success of randomly using an isolated element out of the context of the patent or publication teaching.

In addition, despite improperly picking and choosing from among the four cited references, all elements of the applicants' claimed invention still were not taught (use of an amine resistant polysiloxane or for teaching the requisite concentration of capsaicin in the microreservoir droplets) even for independent claim 1.

For any of the above reasons, the Examiner clearly erred in holding the applicants' claims were obvious over U.S. Patent 5,788,983 ('983 patent) in view of U.S. Patents 6,348,501 ('501 patent) and 6,818,671 ('671 patent) and U.S. Patent Appl. Publ.2005-0079206 ('206 application).

Given the page constraints for this Review, arguments for the missing elements for the dependent claims will be presented on Appeal, if necessary. Applicants note that yet another reference, five (5) total, was required to reject claim 12 (U.S. Patent 7,247,315) and claim 16 (U.S. Patent 5,494,680).